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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/827,933      | 04/09/2001  | Rainer K. Schmid     | 032004-005          | 6673             |

7590 05/09/2003

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EXAMINER

MOHANDESI, JILA M

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3728

DATE MAILED: 05/09/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/827,933

Applicant(s)

SCHMID, RAINER K.

Examiner

Jila M Mohandesi

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 17 April 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Request For Continued Examination***

1. The request filed on April 17, 2003 for a Request For Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/827,933 is acceptable and a RCE has been established. An action on the RCE follows.

### ***Claim Objections***

2. Claims 4, 7 and 16 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The limitation the separating element comprises an elastomeric material is already in the twice amended claims 1 and 8. The limitation said first and second rigid plates define an energy return system is already in the twice amended claim 1.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 8, 12, 16, 17, 25, 26, 27 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by (Katz (4,279,415). Katz `415 discloses an energy return system comprising: a first rigid plate (12); a second rigid plate (10) spaced a predetermined distance from said first rigid plate (see Figure 2 embodiment); at least one elastomeric

Art Unit: 3728

separating element (crushable, resilient, capable of returning to its original shape polyurethane material 18) maintaining the distance between the first and second rigid plates, the separating element allowing independent movement of the first and second rigid plates with respect to one another in multiple dimensions including medial lateral movement and vertical movement.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-12 and 14-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jacinth (4,592,153). Jacinth `153 discloses an article of footwear comprising: an upper; an outsole defining a ground engaging surface; a sole disposed between said upper and said sole (rubber 19), said sole including an energy return system (11); wherein said energy return system comprises a first rigid plate (high-carbon steel alloy plate 13), a second rigid plate (high-carbon steel plate 17) spaced apart a predetermined distance from said first rigid plate, and at least one elastomeric separating element (arcuate synthetic resilient material 27, 35, 37) disposed there between to maintain the spacing between said plates, separating element allowing independent movement of the first and second rigid plates with respect to one another in multiple dimensions including medial lateral movement and vertical movement. The

Art Unit: 3728

first and second rigid plates not immovably being fixed to one another. See Figure 3 embodiment.

If there is any doubt that the resilient synthetic material (27, 35, 37) is elastomeric material, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the material of the resilient material since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

With respect to claims 2, 3, 9, 10, 11 which further limits the high-carbon steel material of the rigid plates, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

With respect to claims 12, 14, 15, 23, 27 and 31, see column 3, lines 1-3.

With respect to claims 17, 21, 25, 26 and 29, see the two separating elements (37) in Figure 3 embodiment which allow the first and second plates to move independently of one another in all dimensions.

7. Claims 2-3, 9-11, 12-13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jacinto '153 in view of Schmid (4,858,338). Jacinto '153 as described above discloses all the limitations of the claims except for the specifics of the high-carbon steel material of the rigid plates. Schmid '338 discloses an insert/sole (20) for an article of footwear where the insert/sole absorbs, stores and returns the kinetic energy of a wearer to the wearer's foot. The insert/sole (20) is made of an elastic

Art Unit: 3728

material which is defined as a high tensile strength material which has a modulus of elasticity of at least 32X10 lb/in made of a plurality of Graphite fibers. Graphite fibers have the advantages that they have a high tensile strength, a high modulus of elasticity, are lightweight, and can be easily processed. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the rigid plates of Jacinto `153 from plurality of Graphite fibers as taught by Schmid `338 to enhance the energy return properties of the energy return system. Furthermore, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

With respect to claim 13, the insert/sole of Schmid `338 discloses a rocker bottom (28) to cradle the first metatarsal head of the foot of the wearer. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a rocker bottom to the first and second rigid plates of Jacinto `153 as taught by Schmid `338 to better cradle the foot of the wearer.

### ***Response to Arguments***

8. Applicant's arguments with respect to claims 1-32 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shown are energy return systems analogous to applicant's invention.

Art Unit: 3728

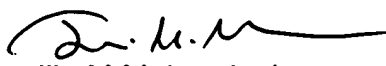
10. Telephone inquiries regarding the status of application or other general questions, by persons entitled to the information "should be directed to the group clerical personnel and not to the Examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148 or the Tech Center 3700 Customer Service Center number is (703) 306-5648. For applicant's convenience, the Group Technological Center FAX number is (703) 872-9302. (Note that the Examiner cannot confirm receipt of faxes) Please identify Examiner Mohandesi of Art Unit 3728 at the top of your cover sheet of any correspondence submitted. Inquiries only concerning the merits of the examination should be directed to Jila Mohandesi whose telephone number is (703) 305-7015. The examiner can normally be reached on Monday-Friday 7:30-4:00 (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (703) 308-2672.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g. copies of references cited, form PTO-1449, for PTO-892, etc. requests for copies of such papers should be directed to Donna Monroe at (703) 308-2209.

Check out our web-site at "www.uspto.gov" for fees and other useful information.

J. MOHANDESI  
PATENT EXAMINER

  
Jila M Mohandesi  
Examiner  
Art Unit 3728

Application/Control Number: 09/827,933

Art Unit: 3728

Page 7

JMM

May 2, 2003